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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,992	12/06/2001	Lawrence W. Stark	018158-018610US	1090
73517 7590 07/21/2010 Townsend and Townsend and Crew LLP/AMO Two Embarcadero Center, Eighth Floor San Francisco, CA 94111				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3769				
MAIL DATE		DELIVERY MODE		
07/21/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/006,992

Applicant(s)

STARK ET AL.

Examiner

david shay

Art Unit

3769

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 23, 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20 and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Guidelines for using 37 CFR 1.105 to Require Applicant to Identify Double Patenting Issues

The criteria stated in 37 CFR 1.105 for making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application. The information required would typically be that necessary for finding prior art or for resolving an issue arising from the results of the search for art or from analysis of the application file. A requirement for information necessary for finding prior art is not a substitute for the examiner performing a search of the relevant prior art; the examiner must make a search of the art according to MPEP § 704.01 and §§ 904 – 904.03.

The criteria of reasonable necessity is generally met, e.g., where:

- (A) the examiner's search and preliminary analysis demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents and typical sources of non-patent literature, or
- (B) either the application file or the lack of relevant prior art found in the examiner's search justifies asking the applicant if he or she has information that would be relevant to the patentability determination. The first instance generally occurs where the invention as a whole is in a new area of technology which has no patent classification or has a class with few pieces of art that diverge substantially from the nature of the claimed subject matter. In this situation, the applicant is likely to be among the most knowledgeable in the art, as evidenced by the scarcity of art, and requiring the applicant's information of areas of search is justified by the need for the applicant's expertise. The second instance generally occurs where the application file, or other related applications or publications authored by the applicant, suggests the applicant likely has access to information necessary to a more complete understanding of the invention and its

context. In this situation, the record suggests that the details of such information may be relevant to the issue of patentability, and thus shows the need for information in addition to that already submitted by the applicant.

37 CFR 1.105(a)(1)(i)-(viii) lists specific examples of information that may be reasonably required. Other examples, not meant to be exhaustive, of information that may be reasonably required for examination of an application include:

- (A) The name and citation of any particularly relevant indexed journal, or treatise.
- (B) The trade name of any goods or services the claimed subject matter is embodied in.
- (C) The citation for, the dates initially published and copies of any advertising and promotional literature prepared for any goods or services the claimed subject matter has been embodied in.
- (D) The citation for and copies of any journal articles describing any goods or services the claimed subject matter has been embodied in.
- (E) The trade names and providers of any goods or services in competition with the goods or services the claimed subject matter has been embodied in.
- (F) Any written descriptions or analyses, prepared by any of the inventors or assignees, of goods or services in competition with the goods or services the claimed subject matter has been embodied in.
- (G) Identification of pending or abandoned applications filed by at least one of the inventors or assigned to the same assignee as the current application that disclose similar subject matter that are not otherwise identified in the current application.

- (H) A reply to a matter raised in a protest under 37 CFR 1.291.
- (I) An explanation of technical material in a publication, such as one of the inventor's publications.
- (J) The identification of changes made in a reformatted continuing application filed under 37 CFR 1.53(b).
- (K) A mark-up for a continuation-in-part application showing the subject matter added where there is an intervening reference.
- (L) Comments on a new decision by the Federal Circuit that appears on point.
- (M) The publication date of an undated document mentioned by applicant that may qualify as printed publication prior art (35 U.S.C. 102(a) or (b)).
- (N) Comments on information of record which raises a question of whether applicant derived the invention from another under 35 U.S.C. 102(f).
- (O) Art related to applicant's invention, applicant's disclosure, or the claimed subject matter.
- (P) Other factual information pertinent to patentability.
- (Q) The accuracy of the examiner's stated analysis of such items.
- (R) Clarification of the correlation and identification of what structure, material, or acts set forth in the specification would be capable of carrying out a function recited in a means or steps plus function claim limitation. If it is not apparent to the examiner where in the specification and drawings there is support for a particular claim limitation reciting a means to accomplish a function, and if an inquiry by the examiner for such support is met by a stated lack of knowledge thereof by the applicant, the examiner could very well conclude that there is no

such support and make appropriate rejections under, for example, 35 U.S.C. 112, first paragraph (written description) and 35 U.S.C. 112, second paragraph.

37 CFR 1.105 REQUIREMENT FOR INFORMATION

Applicant (or the assignee of this application if the assignee has undertaken the prosecution of the application) is required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

There are numerous other co-pending applications and issued patents, which disclose and claim very similar and/or identical subject matter. In accordance with 37 CFR 1.105 and MPEP 704.11(a), applicant (or the assignee) is respectfully requested provide information concerning the analysis of the accuracy of gradient fields; the application of surface integrals to the determination of the accuracy of data arrays or points; application of Green's Theorem to determining the validity of either data points or data arrays.

The information is required to extend the domain of search for prior art. Limited amounts of art related to the claimed subject matter are available within the Office, and are generally found in class 606; subclasses 10-12, which describe Laser surgical systems. A broader range of art to search is necessary to establish the level of knowledge of those of ordinary skill in the claimed subject matter art of determining the accuracy of a gradient field.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 3 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

The examiner notes applicant's citation of MPEP 707.02 and is treating the instant case as "special" as it qualifies for such treatment under this section of the MPEP.

Applicant also notes that any new rejection of claims 19, 20, and 36-44 will preclude the making this office action final.

With regard to the rejections which applicant refers to as "ambiguous" the examiner notes that these were references which were contained in responses to arguments that were erroneously left in the office action from a previous office action. As a point of fact, the examiner must respectfully note that the statement that the combination applied in the Examiner's Answer teaches the claimed method, is merely a statement, and not a rejection. There is no statement in the previous office action that the claims are rejected under this combination, merely a statement that the combination teaches what is claimed.

With regard to the rejection under 35 U.S.C. 101, applicant requests clarification regarding the rejection under 35 U.S.C. 101 since the "Advisory Action (sic, Interview Summary) mailed October 25, 2006 stated that the § 101 is not applicable to at least claim 39" (see the instant response, page 12, second full paragraph, emphasis in original). The examiner notes that a careful reading of the office action to which the instant submission purports to be a response does not in fact reject claim 39 under 35 U.S.C. 101, thus no clarification is deemed necessary.

With regard to applicant's arguments drawn to the application of the "mental steps" test, the examiner must respectfully note that the reference to "mental steps" has been deleted from the applied rejection for the last several office actions. However, the examiner has restated the rejection without using the term "mental" as this seems to have confused applicant.

With regard to the rejection under 35 U.S.C. 101 that the instant claims (excepting claim 39) are non-statutory under the Bilski transformation rule, applicant argues that "claim 18 provides statutory subject matter under Bilski, because it involves transmitting an image through optical tissue, thus resulting in a physical transformation of a physical substance" (see the instant response, page 13, the first sentence of the penultimate paragraph). The examiner can find no "physical transformation of a physical substance" in the step discussed by applicant. The image transmitted through the optical tissue is for diagnostic purposes. As one of ordinary skill in the art would understand, the purpose of diagnosis is to determine a condition without affecting the organ tested. Thus there is no transformation to the eye. The image is merely light waves, and as such does not constitute a "substance" (substance 1a. "That which has mass and occupies space; matter" American Heritage Dictionary), thus even if the image can be argued to be transformed, there is no physical substance involved in the transformation. Therefore, the transformation of light waves does not meet the physical transformation test of Bilski. Thus, these arguments are not convincing.

The showing that the Oderich reference was commonly assigned at the time of the invention, with a filing date less than a year from the instant filing date is convincing, thus this rejection has been withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 18-20, 36-38, and 40-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is merely transmitting an image through optical tissue, which does not transform or alter the tissue in any way and a set of calculations, and is thus drawn to a process which produces no physical transformation (see *In re Bilski*, 88 USPQ2d 1385 (Fed Cir 2008)) as such, since the claims do not result in a physical transformation, they are non-statutory.

Applicant's arguments filed October 10, 2009 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/
Primary Examiner, Art Unit 3769